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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,054	02/28/2002	Shuuji Yano	Q68759	6446
23373	7590	08/10/2004	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			WANG, GEORGE Y	
			ART UNIT	PAPER NUMBER
			2871	

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/084,054	Applicant(s) YANO ET AL.	
	Examiner George Y. Wang	Art Unit 2871	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimi et al. (U.S. Patent No. 5,245,456, from hereinafter "Yoshimi") in view of Michihata et al. (U.S. 6,320,042, from hereinafter "Michihata") and Ishii et al. (U.S. Pub. No. 2003/0049459, from hereinafter "Ishii").

3. As to claim 1, Yoshimi discloses an optically compensatory polarizer having a polarizer (fig. 5, ref. 5) including an absorption-type polarizing element, a transparent protective layer (col. 4, lines 28-53; col. 7, lines 22-28) on each of the opposite sides of the polarizing element, and one optically compensating film laminated on surface of the polarizer so that a slow axis of each optically compensating film crosses an absorption axis of the polarizer perpendicularly and where the film exhibits an in-plane retardation in a range from 80 to 200 nm (col. 5, line 41) and $N_z = (n_x - n_z) / (n_x - n_y)$ (col. 4, lines 7-27) in a range from -0.2 to 0.2 (col. 4, line 57) where n_z is the refractive index in the direction of the z axis of the compensating film that expresses thickness, n_x in the x-axis direction that expresses a direction perpendicular to z, and n_y in the y-axis that expressed a direction perpendicular to both z and x, and where $n_x > n_y$ (col. 4, line 57).

However, the reference fails to specifically disclose transparent protective layers each exhibiting an in-plane retardation of not larger than 10 nm and a thickness retardation in the range from 30 to 70 nm.

Ishii discloses a transparent protective layer exhibiting an in-plane retardation of not larger than 10 nm (abstract) and Michihata discloses a protective layer with a thicknesswise retardation in the range from 30 to 70 nm (col. 9, lines 14-16).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have integrated the aforementioned specifics of the transparent protective layers since one would be motivated to minimize foreign particles (Michihata, col. 1, lines 42-49), improve durability and polarization efficiency by preventing drop in polarization efficiency, hue shift, and light leakage (Ishii, [0001], [0008], [0011]-[0015]).

4. Regarding claim 2, Yoshimi discloses a liquid crystal display device (fig. 5) with a liquid crystal cell (fig. 5, ref. 6) with an optically compensating polarizer (fig. 5, ref. 5) as recited above, provided on at least one of the opposite surfaces of the cell.

Response to Arguments

5. Applicant's arguments filed March 1, 2004 have been fully considered but they are not persuasive.

Applicant's main argument is that "none of the cited references discloses or teaches to suppress light leak and coloring of leaked light by the combination of a transparent protective film and an optically compensating film with particular optical characteristics as taught by the present invention." However, Examiner disagrees because nowhere in Claim 1 or 2 are these features recited. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues that the combination of the Michihata and Ishii references to Yoshimi are based on improper motivation. Examiner disagrees. While it is true that Michihata also discusses the use of a cellulose ester film, Applicant's assertion that the minimization of foreign particles is obtained by this layer is not taught in col. 1, lines 42-49. Furthermore, Applicant's argument that the Ishii reference is not concerned with the actual value of the in-plan retardation but rather the change or shift of the value of the in-plane retardation over time due to exposure to extreme

environmental conditions does not render the motivation inoperative. Rather, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Furthermore, the feature of durability and polarization efficiency are nowhere to be found in Applicant's claim language.

Therefore, Examiner holds to the validity of the references used and maintains rejection.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Y. Wang whose telephone number is 571-272-2304. The examiner can normally be reached on M-F, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert H. Kim can be reached on 571-272-2293. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gw
August 9, 2004


George Y. CHOWDHURY
Primary Examiner